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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,815	06/04/2001	Egidio Lavorgna JR.	60709-00017	4578

7590

03/09/2006

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,815

Applicant(s)

LAVORRNA ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 39-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13, 39-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/18/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 8/23/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In independent method claim 39, the 5th (or (e)) and 9th (or (i)) steps of:

(e) linking selected data fields ... within the business entity;

(i) generating using the server ... based on the hierarchy of entities”.

And similarly, independent claims 40, 52, and 64, which have similar steps (e) and (i) as in independent method claim 39 above, there are no supported in the specification and drawings for these steps. The examiner has reviewed the specification and drawings carefully but could not find the exact supports for these limitations.

Applicant is required to cancel the new matter in the reply to this Office Action or show the examiner where are the supports in the specifications for the amended language.

Claim Status

Claims 2-13, 39-64 are active and are rejected as followed. Claims 1, 14-38 have been cancelled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful (1) process, (2) machine, (3) manufacture, or (4) composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 64 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 64 calls for a computer program embodied on a computer readable medium, wherein said program comprising at least one code segment that stores in a database a plurality of web pages including a create template web page and then steps (a)-(i). The claims fail to include that the computer programs comprised of instructions, which when read and executed by a computer, cause the computer to perform the steps (a)-(i) above. Therefore, claim 64 as shown is not considered as an article of manufacture since it's merely programs stored in a medium and is not statutory subject matter. Insertion of the limitation of "that the computer programs comprised of instructions, which when read and executed by a computer, cause the computer to perform the steps (a)-(i)" above is needed to overcome the 101 rejection.

Claim Rejections - 35 USC § 112

3. Claims 39, 2-13, 40-51, 52-63, and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 39, line 5, 2nd step (b), it's not clear the relationship of the phrase "a customized template for receiving business metrics" to the rest of the body of claim 39. Are the "created template" in steps (c)-(i) refer to the "customized template of (b)?"

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(2) In claim 39, line 9, the phrase “the 1st user to designate a number of data fields” is not clear. Is designating means “creating or forming” etc.?

(3) In claim 39, step (e) is vague and indefinite. It’s not clear how “linking the created template to the at least one hierarchy of entities for restricting access to the created template to only selected business units included within the business entity” is carried out and what it really means? An example is needed. What happened to the “combined data for a plurality of selected business units”? Is it used anywhere in any of the steps below it? Moreover, the phrase “selected data fields” lacks antecedent basis. There is no step of “selecting the data fields” above.

(4) In claim 39, it’s not clear the relationship of the last two steps (h) and (i)? What are the analyzed business metrics used for? The generated reports do not appear to include any analyzed business metrics.

(5) In claim 39, lines 27-29 are vague. Line 25 indicates a 1st report showing data (business metrics) appears to be okay. However, the phrase “a 2nd report combining business metrics ... entities” is vague since it’s not clear what the 2nd report shows?

Similarly, independent claims 40, 52, and 64, which have similar steps (a)-(i) as in independent method claim 39 above, are rejected for the same reasons indicated above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 39, 2-13, 40-51, 52-63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (or AAPA) in view of (2) BERNADO et al (US 6,684,369) and (3) FLEMING et al (US 2002/0059264).**

As for independent method claim 39, as shown in the background of the invention [0003-0005], AAPA discloses a method for managing business activities (tasks) using business metrics measurements (numbers and data) by manually (1) compiling the data from multiple different business units, (2) analyzing the data, (3) generating a report about the result of the analysis, and (4) assessing the business metrics {[0003, 0004]}. Typical business metrics include service quality, ratings of customers, productivity and employee satisfaction survey {see [0003]}. AAPA fails to teach the carryout of the managing of the business activities automatically using a server system coupled to a database and web pages including a template and managing the business metrics using the template web page.

BERNADO et al fairly discloses a method for managing business activities (tasks) using business metrics by automatically using a server system coupled to a database and web pages including a template and managing the business activities using the template web page {see Figs. 5, Site Areas: "contact management area, customer tracking area, project management area, etc.", Fig. 1, Fig. 2}. It would have been obvious to modify the manually managing business activities of AAPA to automatically managing business activities using website/web pages as taught by BERNADO et al to obtain well known benefits of the Internet such as high efficiency, availability, accessibility, costs, etc. Note also that replacing manual activity with automatic/computer/Internet activity is well known and would have been obvious to a skilled artisan. In re Vennel, 120 UQ 192. Alternatively, it would have been obvious to

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modify the teachings of AAPA with BERNADO et al for the well known teaching, conversion from manual to automatic/computer/Internet, as taught in In re Vennel.

As for the steps of:

(a) , "storing in the database ...", this is taught in BERNADO et al Fig. 1, abstract;

(b) "prompting a 1st user (creator) to create ... ", this is taught in BERNADO et al col. 6, lines 32-67, col. 7, lines 7-67, Figs. 5-8, 12, 20};

(c.) "creating at least one hierarchy of entities ... ", and (d) of "linking the created template ..for restricting access to the created template..." , are fairly taught in BERNADO et al on col. 8, lines 15-67;

(e) "linking selected data fields ..", this is fairly taught in BERNADO et al col. 6, lines 52-56 " .. *module that combines the templates..*", col. 10, lines 40-50, col. 14, lines 20-35;

(f) "displaying the created template ..."

(g) "storing the business metrics ..."

(h) "analyzing the business metrics ...", are taught in BERNADO et al on col. 6, lines 36-60, col. 10, lines 19-53 "Stored Pages"; and

(i) "generating information/data in the form of reports", this is fairly taught in Figs. 26, 27, 28 "Forms", col. 20, lines 8-24, 56-65, col. 23, lines 49-60 and in view of AAPA [0004 "*capturing, analyzing, reporting and assessing business metrics*"].

In similar a business management FLEMING et al is cited to teach the concept of combining business data from multiple sources (business units) within an enterprise (entity) for analysis of historical trends and generating reports of the results/analysis to

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the entity for reviewing and making corrective actions in a today's fast paced, competitive and rapidly changing business market {[0003, 0009, 0089], Fig. 7, (302). It would have been obvious to modify the teachings of AAPA/BERNADO et al by combining business data from multiple sources (business units) and generating reports as taught by FLEMING et al to make corrective actions in a fast paced, competitive and rapidly changing market with dispersed business units. As for the different types of reports or the different contents of the type of reports, these are merely reporting format parameters and the adjusting of these parameters to meet specific condition are within the skill of the artisan and would have been obvious, absent evidence of unexpected results. See In re Jones, 162 UQ 224.

As for dep. claim 2 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. having a calculation formula, this is non-essential to the scope of the claimed invention and is taught in BERNADO et al col. 6, lines 37-38.

As for dep. claim 3 (part of 39 above), which deal with well known data analysis parameters, i.e. performing at least 1 mathematical computation and generating a trend analysis, this is taught in FLEMING et al [0009].

As for dep. claim 4 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. assign a definition to each data field, this is non-essential to the scope of the claimed invention and is taught in BERNADO et al Figs. 6-7.

As for dep. claim 5 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. creating a data field for validating a business metrics, this is non-essential to the scope of the claimed invention and is taught in BERNADO et al cols. 8, 11-12.

As for dep. claim 6 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. a drop-down box or list for entering data, this is non-essential to the scope of the claimed invention and is taught in BERNADO et al Figs. 6 or 16 or FLEMING et al Fig. 4 or 13.

As for dep. claims 7-9 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. linking of an data to other data or field or other elements, these are non-essential to the scope of the claimed invention and are taught in BERNADO et al col. 10, lines 40-50, col. 14, lines 24-26.

As for dep. claims 10-13 (part of 39 above), which deal with well known template creating/customizing parameters, i.e. features such as editing, changing , modifying, etc., these are non-essential to the scope of the claimed invention and are taught in BERNADO et al col. 8, lines 15-20, col. 11, lines 48-67.

As for independent system claim 40, which basically is the system to carry out the method of claim 39 above, it's rejected over the system to carry out the independent method claim 39 as indicated by AAPA / BERNADO et al /FLEMING et al cited above. Moreover, it would have been obvious to a skilled artisan to set up an equivalent system to carry out the respective method claim 39 as cited above.

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As for dep. claims 41-51 (part of 40 above), which have the same limitations as in dep. claims 2-13 above, they are rejected for the same reasons set forth in dep. claims 2-13 above.

As for independent apparatus claim 52, which basically is the apparatus to carry out the method of claim 39 above, it's rejected over the system to carry out the independent method claim 39 as indicated by AAPA / BERNADO et al / FLEMING et al cited above. Moreover, it would have been obvious to a skilled artisan to set up an equivalent system to carry out the respective method claim 39 as cited above.

As for dep. claims 53-63 (part of 40 above), which have the same limitations as in dep. claims 2-13 above, they are rejected for the same reasons set forth in dep. claims 2-13 above.

As for independent product claim 64, which basically is a computer program embodied on a computer readable medium to carry out the independent method of claim 39 above, it's rejected over the computer program product of system to carry out the independent method claim 39 as indicated by AAPA / BERNADO et al / FLEMING et al cited above. Moreover, it would have been obvious to a skilled artisan to create a computer program system to carry out the respective method claim 39 as cited above. See BERNADO et al claim 11.

Response to Arguments

8. Applicant's arguments filed 8/23/05 with respect to the 102/103 rejections of claims 1-13, 14-18, 19-25, 26-29, 30-33, 34-37, 38-39 over DAUDENARDE have been considered but are moot in view of the new ground(s) of rejection which are due to applicant's amendments.

As for the 101 and 112, 2nd paragraphs, rejections from the previous office actions, applicant's amendments have overcome these rejections. However, new set of 101 and 112, 2nd paragraph rejections are generated from the new set of claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2992/0173997, by MENARD et al, also discloses a method and system for monitoring business metric results, analyze the results, and reporting the results on the Internet/web pages {see Figs. 1, 2, 3, 4 and 7}. It's cited here for applicant's awareness of potential use in the future if needed to avoid duplicate rejections.

No claims are allowed.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 06, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER